

Attorney Docket No.: P-US-TN-3305
Application Serial No.: 10/688,668

REMARKS

The Office Action dated February 18, 2010, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claims 1, 66, 67, 83 and 84 have been. No new matter is presented. Support for the amendments to claim 1 can be found in at least paragraph [0052] and Figure 4 of the specification and abstract as originally filed. Support for the amendments to claims 66, 67, 83 and 84 can be found in at least Figures 13A and 13B of the application as originally filed. Claims 1-3, 5, 66-69, 71 and 80, 81 and 83-85 are pending and respectfully submitted for consideration.

Rejections Under 35 U.S.C. § 103

Claims 1-4

Claims 1-3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee (U.S. Patent No. 5,676,124, "Lee '124") in view of Greenland (U.S. Patent No. 6,276,990, "Greenland '990") and further in view of Tsao (U.S. Patent No. 6,263,866). Claims 2 and 3 depend from claim 1.

Lee '124 was cited for disclosing many of the claimed elements of the invention with the exception of a motor assembly pivotably supported by the support assembly, the support assembly remaining stationary relative to the pivotal movement of the motor assembly, and the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis. Greenland '990 and Tsao were cited for curing this deficiency. The Applicant traverses the rejection and respectfully submit that claims 1-3 recite subject matter that is neither disclosed nor suggested by the cited references.

Claim 1, as amended, recites one of the frame assembly and the support assembly has a first post, and the other of the frame assembly and the support assembly has a first hole for receiving the first post; and one of the frame assembly and the support assembly has a second post, and the other of the frame assembly and the support assembly has a second hole for receiving the second post, wherein the first hole and second hole are blind holes. The Office Action asserted that the cutting head assembly 18, frame 12 and screws in Lee '124 were

Attorney Docket No.: P-US-TN-3305
Application Serial No.: 10/688,668

comparable to the claimed support assembly, frame assembly and posts. In contrast, Lee '124 discloses that the holes in the frame 12 are through holes for the screws. Greenland '990 and Tsao fail to cure this deficiency in Lee '124 as the references also do not disclose or suggest at least the feature of the first hole and second hole being blind holes. Therefore, the combination of Lee '124, Greenland and Tsao does not disclose or suggest the features of the invention as recited in claim 1 and thereby, dependent claims 2 and 3.

In view of the above, the Applicant respectfully requests withdrawal of the rejection of claims 1-3.

Claim 5

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee '124 in view of Greenland '990, Tsao and Fuhrman et al. (U.S. Patent No. 6,637,424, "Fuhrman"). Claim 5 depends from claim 1.

As a preliminary matter, the Applicant respectfully submits that the Office Action did not explain how Fuhrman is being applied to claim 5. The Office Action states that "Greenland tile saw disclose[s] a similar setup to the Lee tile saw, except that the frame is formed from aluminum instead of steel." See page 5, paragraph 4 of the Office Action. However, Greenland '990 discloses a steel frame 12. See column 3, lines 48-50 of Greenland '990. It appears that the Office Action is attempting to reference Fuhrman.

Nevertheless, Fuhrman fails to cure the deficiencies in Tsao and Greenland '990 with respect to claim 1 and therefore, dependent claim 5, as Fuhrman also does not disclose or suggest that the first hole and second hole are blind holes.

In view of the above, the Applicant respectfully requests withdrawal of the rejection of claim 5.

Claims 66-68, 80 and 82-84

Claims 66-68, 80 and 82-84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsao (U.S. Patent No. 6,263,866) in view of Greenland '990".

As a preliminary matter, as stated in the previous Office Action, claim 82 has been canceled.

Attorney Docket No.: P-US-TN-3305
Application Serial No.: 10/688,668

Also, claim 80 depends from claim 1. Claim 1 was rejected in view of the Lee '124 patent, however, Lee '124 was not applied to claim 80, which includes the subject matter of claim 1, for example, the first and second posts. Tsao and Greenland '990 do not disclose or suggest the claimed first and second posts. Therefore, the combination of references do not support a *prima facie* case of obviousness for purposes of a rejection of claim 80. As such, the Applicant respectfully requests withdrawal of the rejection of claim 80.

Claims 68 and 84 depend from claim 67 and claim 83 depends from claim 66. Tsao was cited for disclosing many of the claimed elements of the invention with the exception of:

the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis, and a switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary, wherein the support assembly comprises a generally U-shaped member having first and second legs with the switch disposed on the U-shaped member and the motor assembly pivotably supported by the first and second legs.

Greenland '990 was cited for curing these deficiencies. The Applicant traverses the rejection and respectfully submits that claims 66-68, 83 and 84 recite subject matter that is neither disclosed nor suggested by the cited references.

Claims 66 and 67, as amended, recite, in part, a switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the bevel axis, the switch remains stationary. The Office Action acknowledged that "the modified device of Tsao still does not disclose that the location of the switch is such that the switch is disposed on the generally U-shaped member." See page 8 of the Office Action. The Office Action then cited Lee (U.S. Patent No. 6,272,961, "Lee '961), Jameson (U.S. Patent No. 3,777,792), Weissman (U.S. Patent No. 4,885,956), Mayfield (U.S. Patent No. 5,063,806), Rueb (U.S. Patent No. 5,577,428), Welch (U.S. Patent No. 5,906,528), Greenland (U.S. Patent No. 6,080,041, "Greenland '041"), and Gorgol et al. (U.S. Patent No. 6,273,081) "as cumulative evidence that it is well known in the art to locate the power switch for a cutting tool almost anywhere on a saw." See page 8 of the Office Action.

In contrast, the Applicant respectfully submits that the cited references are evidence that it is not well known in the art to locate a switch electrically connected to the motor on a support

Attorney Docket No.: P-US-TN-3305
Application Serial No.: 10/688,668

assembly, so that when the motor assembly is pivoted about the bevel axis, the switch remains stationary, for the following reasons.

Each of the cited references (Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol) fall into one of two types of switch arrangements. The references disclose either a stationary switch with a motor that is non-longitudinally movable or non-pivotable about a bevel axis (Jameson, Weissman, Rueb, Welch) or a switch that moves with a longitudinally movable motor (Lee '961, Mayfield, Greenland). Although Gorgol is cited by the Office Action, this reference does not disclose a switch or suggest a location for a switch and therefore, does not support the Office Action position.

In view of the above-cited references, the Applicant respectfully submits that none disclose or suggest a motor that pivots about a bevel axis and has a stationary switch. Further, no evidence is provided by the Office Action that shows the location of a switch on a stationary support assembly in combination with a motor assembly pivoting about a bevel axis.

In addition, in the modified device of Tsao (Tsao in combination with Greenland '990) the Office Action asserted that the supporting arm 16 was comparable to the claimed generally U-shaped member. In the previous response filed January 6, 2010, the Applicant set forth that the modified device of Tsao teaches away from a switch disposed on a generally U-shaped member. In the Response to Arguments section of the present Office Action, the Office Action stated that Greenland '990 discloses "manual switch 28, provided on the motor housing 24 by which to turn the power on and off. Thus there are two activation mechanisms, one switch 28 to provide power to the saw and another switch to turn the motor on once the switch 28 is activated." See page 11, paragraph 9 of the Office Action. However, the Applicant submits that the manual switch 28 again on the motor in Greenland '990 is further evidence that it would not have been obvious to locate the switch off of the motor, as claimed in claims 66 and 67.

Further, it is not well known in the art to locate the power switch for a motor assembly that pivots about a bevel axis on a stationary support assembly as set forth in the affidavit of inventor Stuart Wright, submitted with the response filed November 15, 2006, "this positioning of the power switch enhances the ability of the user to locate the switch during operation of the tile saw. This enables the user to both turn on and shut off the tile saw quickly and easily without having to adjust the position of other portions of the tile saw. In addition, this positioning of the tile saw switch reduces user fatigue and frustration when using the tile saw."

Attorney Docket No.: P-US-TN-3305

Application Serial No.: 10/688,668

The Applicant further submits that none of Lee '961, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol disclose or suggest even the feature of the switch disposed on a U-shaped member. Under U.S. patent practice, silence in a reference is not a proper substitute for adequate disclosure of facts from which a conclusion of obviousness may justifiably follow. See, e.g., In re Burt, 148 USPQ 548 (CCPA 1966). Therefore, without any adequate disclosure or suggestion that the switches in the cited references are on a U-shaped member, the cited references further fail to cure the deficiencies in the combination of Tsao and Greenland '990.

In view of the above, the combination of Tsao, Greenland '990 Lee '961, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol do not teach or suggest the claimed features of the invention as recited in claims 66 and 67, and thereby fail to support a *prima facie* case of obviousness of claims 66 and 67.

Accordingly, the Applicant respectfully submits that claims 66 and 67 and dependent claims 68, 81, 83 and 84 are allowable.

Claims 69, 71 and 81

Claim 69 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsao in view of Greenland '990, Lee '961, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol and further in view of McCambridge et al. (U.S. Patent No. 4,350,193), Marcoux et al. (U.S. Patent No. 3,342,226), Brenta (U.S. Patent No. 4,105,055), Sanfilippo (U.S. Patent No. 6,745,803) and Otto (U.S. Patent No. 5,161,590).

Claims 71 and 81 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsao in view of Greenland '990, Lee '961, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol and further in view of Sigetich et al. (U.S. Patent No. 4,428,159).

The Applicant traverses the rejections and respectfully submit that claims 69, 71 and 81 recite subject matter that is neither disclosed nor suggested by the cited references. Claim 69 depends from claim 67, claim 71 depends from claim 1, and claim 81 depends from claim 66.

As a preliminary matter, the Applicant notes that the rejection of claim 71 does not mention the Lee '124 reference. Claim 71 depends from claim 1 to which the Lee '124 reference was applied, however, Lee '124 was not applied to claim 71, which includes the subject matter of claim 1, for example, the first and second posts. Tsao and Greenland '990 do not disclose or

JUN 18 2010

Attorney Docket No.: P-US-TN-3305

Application Serial No.: 10/688,668

suggest the claimed first and second posts. Therefore, the combination of references do not support a *prima facie* case of obviousness for purposes of a rejection of claim 71.

As discussed above, the combination of Lee '124, Greenland '990, and Tsao fail to teach or suggest the features of the invention as recited in claim 1. Lee '961, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, Gorgol and Sigetich fail cure the deficiencies in Lee '124, Greenland '990 and Tsao as these references also do not disclose that the first hole and second hole are blind holes

As discussed above, the combination of Tsao and Greenland '990 in combination with Lee '961, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol fails to teach or suggest the features of the invention as recited in claims 66 and 67. McCambridge, Marcoux, Brenta, Sanfilippo, Otto and Sigetich further fail to cure the deficiencies in the above-cited references as they also do not disclose or suggest at least the features of a switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the bevel axis, the switch remains stationary. Accordingly, the Applicant respectfully submits that Tsao and Greenland '990 in combination with Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol, McCambridge, Marcoux, Brenta, Sanfilippo, Otto and Sigetich fails to teach or suggest the features of the invention as recited in dependent claims 69 and 81.

In view of the above, the Applicant respectfully submits that there is no disclosure or suggestion of the claimed arrangement of elements recited in the claims. Therefore, the cited references fail to support a *prima facie* case of obviousness for purposes of a rejection of claims 1-3, 5, 66-69, 71, 80, 81, 83 and 84 under 35 U.S.C. § 103. Accordingly, claims 1-3, 5, 66-69, 71, 80, 81, 83 and 84 are not rendered obvious in view of the cited references and should be deemed allowable.

Conclusion

The Applicant does not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, the Applicant has not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application. Moreover, there may be alternative or additional reasons for patentability not discussed in this response.

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JUN 18 2010

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Attorney Docket No.: P-US-TN-3305

Application Serial No.: 10/688,668

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's deposit account No. 02-2548, referencing Attorney Dkt. No. P-US-TN-3305.

Respectfully submitted,

Date:

June 18, 2010

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